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EXAMINER

JANVIER, JEAN D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 11/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/931,677

Applicant(s)

NGUYEN, MARTIN KHANG

Examiner

Jean Janvier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

Response To Applicant's Amendments

The amendments to the specification and the new drawing will not be entered at this time since it appears that they contain new matter. For instance, it appears that the original Application does not refer to any "Super Cheap Store" and a link between the "Super Cheap Store" system and the Retailer's POS system where the coupon is redeemed as featured in new figure 4.

Response To Applicant's Arguments

After reviewing the Applicant's claim amendments, the Examiner does not believe that the claims are in condition for allowance as shown in the present Action. Furthermore, the Examiner maintains his position regarding the lack of disclosure in the specification since the Applicant's related remarks are not persuasive.

Additionally, after reviewing the specification, which lacks a detailed disclosure, the Examiner once again has a lot of questions related to the salient or novel feature or the uniqueness of the claimed invention with respect to the Fajkowski's reference. Moreover, as discussed earlier, the Applicant has left a lot of details out of the specification by assuming that all those details are well known and has drafted claims that are substantially based on those supposedly well known features. Generally speaking, if those features are so well known that they are being omitted from the detailed description, then they cannot be novel. Although there is no 112(1)-enablement problem here, nonetheless, there is a potential 112(1) for lack of disclosure. Finally, one of ordinary skilled in the art can reach the same conclusion upon reading or reviewing the specification.

Further, and in general, Fajkowski discloses a system wherein a user joins a service (discount purchase service or clearinghouse) to become a registered customer or member or subscriber and receives a coupon card, which allows him to participate in the coupon distribution system. Coupons are then scanned into the coupon card by the user (subscriber) or downloaded from a plurality of sources including the Internet and a paging system into the coupon card. Subsequently, the user or subscriber takes the coupon card containing the scanned or downloaded coupons to a participating retailer's where one or more stored coupon is retrieved therefrom and redeemed during a synchronization process when the required product is purchased.

Finally, any additional arguments are herein being moot in view of new grounds of rejection.

DETAILED ACTION

Specification

In general, the specification suffers from a complete disclosure. Throughout the specification, the Applicant bypasses important detailed disclosure by assuming that these details are well known in the art. Although these details may be well documented in the art and a 112(1) enablement problem cannot properly be raised, however, this lack of disclosure can trigger a 112(1) for insufficient support can be raised if need. The fact that certain materials are well known in the art does not necessarily mean that they should not be presented, for clarity, in the specification.

Status of the claims

Claims 1-11 are herein being considered for examination.

General Comments

First, the specification suffers from a complete disclosure. Throughout the specification, the Applicant bypasses important detailed disclosure by assuming that these details are well known in the art. Although these details may be well documented in the art and a 112(1) enablement problem cannot properly be raised, however, this lack of disclosure can trigger a 112(1) for insufficient support if need. The fact that certain materials are well known in the art does not necessarily mean that they should not be presented, for clarity, in the specification. **For instance, throughout the specification, it is not clear whether the customer presents the coupon wallet at a retailer's POS to redeem at least one coupon having this noticeable mark imprinted thereon or whether the coupon having this noticeable is presented for redemption or the coupon data are electronically transmitted to the retailer's POS database where the coupon wallet is used as a piece of ID to identify the customer during a transaction or redemption process. In the case the coupon data are scanned or encoded into the wallet or they are electronically transmitted to the retailer's database, the means to do so are not provided therein.** Applicant here cannot simply assume that these means are well known and expect the Examiner to decide which one of these means is used to implement the method of the invention. At this point, at least a card reader/writer should have been briefly disclosed in the specification or drawings. Having said that, the format or the medium used to

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imprint or encode the coupon data and presented at the retailer's POS should clearly be defined in the claim and supported in the specification. That aspect plays an important role in the Examiner's decision on patentability. That is why the Applicant is invited to contact the Examiner to discuss these important matters as soon as possible.

Claim Objections

Claims 1-11 is objected to because of the following informalities-

Throughout the claimed invention, "publically" should apparently be - publicly--

Appropriate corrections are required.

Claim Rejections - 35 USC § 112

Claims 1-3 (including their dependent claims if any) are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure, which is not enabling.

Here, elements critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Although the specification, as featured on page 9, expressly discloses that paper coupons or publicly placed coupons are not presented for redemption at a retailer's, nonetheless, **neither the specification nor the claims discloses how the paper coupons are redeemed by the retailer's POS in conjunction with the wallet card or shows whether coupon data, related to a paper coupon having that noticeable mark, are electronically transmitted to the retailer's POS database where the coupon wallet card is used as a piece of ID to identify the customer during a transaction or redemption process or whether the paper coupons having**

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that noticeable mark are scanned or encoded into the memory of the wallet card for storage and later retrieval during a redemption at the retailer's when the wallet card is linked to the retailer's POS system to thereby retrieve therefrom the associated coupon data, corresponding to one paper coupon when the required product is purchased, as one of ordinary skills in the art would have concluded. Having said that, the Examiner does not know how the redemption is performed using, for example, a paper coupon having that mark in conjunction with the coupon wallet card.

Moreover, it appears that the specification only supports encoding or storing other information, but not expressly scanned coupon data, into the coupon wallet card.

Claims 4 and 7 (including their dependent claims if any) are rejected under 35 U.S.C. 112, first paragraph, as based on a lack of disclosure.

Here, regarding claims 4 and 7, although the specification discloses that the wallet card may contain information, such as the card holder identity, contact information, financial data, privilege level and the like, encoded on a bar code or stored in the memory, nonetheless, it appears that the specification does not immediately support storing transaction information and/or coupon data in the memory of the wallet card before distributing the card to the user.

Claims 1-3 (including their dependent claims if any) are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements, **while rendering the claims ambiguous**. See MPEP § 2172.01.

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For instance, throughout the claims, it is not clear whether the customer presents the coupon wallet at a retailer's POS to redeem at least one coupon having this noticeable mark imprinted thereon or whether the coupon having this noticeable is presented for redemption or the coupon data are electronically transmitted to the retailer's POS database where the coupon wallet is used as a piece of ID to identify the customer during a transaction or redemption process. In the case the coupon data are scanned or encoded into the wallet or they are electronically transmitted to the retailer's database, the means to do so are not provided therein.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Fajkowski, WO 98/19229.

As per claims 1-11, Fajkowski discloses a system for providing a coupon card or value card (smart card, PDA), from a coupon card issuer, containing one or more coupons or multiple coupons on a single product or

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service to a customer, who uses the coupon card for redeeming one or more stored coupons during a transaction at a POS or retail establishment, wherein, upon inserting the customer's unique coupon card 1 into the retail establishment periphery device 100 and detecting the presence of at least one stored coupon, scanned or downloaded into the coupon card 1, associated with a product in the customer's order (when a product UPC code stored on the coupon card matches a product UPC code in the customer's order), a price reduction is applied to the customer's transaction and the retail establishment is subsequently credited or reimbursed (receiving payment or paying a rebate to the retailer by the manufacturer related to the redeemed coupon) for honoring or redeeming the at least one coupon retrieved from the customer's **coupon** card 1 (See abstract; page 4: 24 to page 9: 7).

Fajkowski further discloses a system wherein during a transaction process, the periphery device 100 indicates if there is a manufacturer instant rebate for any product currently in the customer's order. In the affirmative, the system downloads the instant rebate information in real-time from the manufacturer's server to the POS and allows the customer to instantly receive credit for the rebate, while quickly and efficiently supplying the manufacturer with transaction data including both the demographic data and

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stimulation power the rebate is intended to provide in the first place, wherein the demographic data are used to further measure the effectiveness of the system and to further distribute rebates to the identified user or customer of the coupon card 1 (page 22: 21-24; page 27: 14-31).

Further, Fajkowski discloses that the coupon card (1) may include a customer's identification number, which allows the provider of the coupon card and/or manufacturer (supplier) to uniquely identify each individual user to whom a coupon card 1 is registered, thereby enabling purchase habits or behavior of each individual user to be extracted from collected sale data associated with each user and used by the supplier or manufacturer in further marketing analysis in order to prepare targeted coupon packages for each individual user, wherein the targeted coupon packages are transmitted to each individual coupon card 1, to offer real-time rebates to a user or to increase/decrease a coupon value of a coupon already stored on an identified coupon card 1 (smart card) in **reaction to** the user's response to a current promotion. Here, **a clearinghouse 300 (management establishment or third party)** receives from a plurality of different POS periphery devices 100, linked to servers 200, related to different stores transaction data associated with the users identified by the coupon cards 1

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and compiles a detailed database of the purchasing habits or behavior of all users of coupon cards 1. From that database, precise marketing profiles and reports can be provided by the clearinghouse to the manufacturer or supplier and used to generate customized coupon packages by the manufacturer or supplier for the benefit of the individual users of the **coupon cards 1**. In general, coupon data directed to a particular user of a coupon card 1 are transmitted from the manufacturer or supplier to the clearinghouse 300 (manager) to be uploaded by a periphery device 100, linked to the clearinghouse 300 (which receives a service fee from the manufacturer or supplier for performing those tasks) via server 200, to the coupon card 1 during a transaction or redemption process at a retail establishment involving the identified coupon card 1. Information on a manufacturer's rebates is supplied to the clearinghouse 300 database and thereby made available to the periphery devices 100 of the various stores. When a periphery device 100 reads the products purchased, by the identified customer bearing the coupon card 1 or smart card, from a store cash register, the periphery device will indicate if there is a manufacturer rebate existing for any of the purchased products. In the affirmative, the rebate information is transmitted in real-time to the periphery device 100 and thus, this paperless

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rebate system allows the consumer or customer to instantly receive credit for rebates transmitted from the clearinghouse 300 (after the consumer purchases the required products), while quickly and efficiently supplying the manufacturer with both the demographic data and stimulation power the rebate is intended to provide (Page 7: 14-24).

Additionally, the clearinghouse 300 (management establishment providing a service) will use transaction data collected from different periphery devices 100 corresponding to different retailers or servers to generate reports for each manufacturer regarding the amounts for which each retailer is entitled as **reimbursement**. The clearinghouse 300 will also act as a remote database for transferring information to the servers for the use and benefit of retailers, manufacturers and consumers alike and (here, the clearinghouse entity will receive a fee for providing or performing these tasks) (Page 4: 64 to Page 5: 38).

Further, Fajkowski also teaches a system wherein transmission of coupon data to the consumer's coupon card 1 (smart card) is conducted by way of digital pager frequency **radio** waves (transmission of coupon data via a wireless communication). One embodiment of the coupon card may include a **radio** frequency (wireless) receiver. The consumer would pre-select a group of coupons he wished to receive from the provider of the coupon card service. At a later date,

the coupon card service provider would broadcast a pager signal, readable by that consumer's coupon card, which would contain the information corresponding with the pre-selected coupons. The consumer would receive the coupon data, related to the pre-selected coupons, on his coupon card as long as he was anywhere within the range of the pager broadcast (receiving by the consumer via his coupon card e-coupons from a paging or wireless system over a wireless network-Page 8: 33 to page 9: 7). The user can scan paper coupons (publicly published coupons) into the coupon card 1 (coupon wallet card) where the scanned coupon data, related to one or more paper coupons, are stored in permanent memory for later retrieval and usage at a retailer's POS during a redemption process. The coupon data can be also be downloaded from a server, connected to the Internet, to the consumer's coupon card 1 (handset) and stored thereon, following the consumer's request, for subsequent retrieval and use during a redemption process at a participating POS.

(See abstract; page 4: 24 to page 9: 7; page 19: 27 to page 20: 8; page 32: 11 to page 33: 6) and figs. 7a-7b, 9 and 15c.

Finally, the publicly published coupons have imprinted thereon graphics, text, bar code, etc. (page 15: 20-27). **Further**, the publicly published coupons have displayed thereon a marker or a noticeable mark indicating the origin or the source of the coupons and those coupons are scanned by the user into the coupon card 1 before they are presented for redemption at retailer's (page 39: 8-25 and claim 6).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 6,354,495B1 to Powell discloses a system for creating, dispensing, and redeeming electronic discount coupons in a store. The system includes a "smart card", product stations adjacent to selected products in the store, and a checkout station in the checkout area. To create an electronic coupon, the customer inserts the card into the product station adjacent to a product the customer wishes to purchase, and the product station then writes an electronic coupon onto the card. The customer thus shops throughout the store collecting electronic coupons for products of interest. Upon completion of shopping, the customer redeems the electronic coupons at the checkout area, by inserting the card into the checkout station. During checkout, when UPC data matches data stored on the card, the customer is credited with the value of the corresponding coupon. Periodically, the electronic coupon data is transferred to a remote clearing house.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner

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by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official- 571-273-6719.

Official Draft : 571-273-8300

11/25/06

JDJ

JEAN D. JANVIER
PRIMARY EXAMINER

Jean D. Janvier